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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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HEWLETT-PACKARD COMPANY
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EXAMINER

AMSBURY, WAYNE P

ART UNIT PAPER NUMBER

2171

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,320

Applicant(s)

PARRY, TRAVIS J.

Examiner

Wayne Amsbury

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

CLAIMS 1-11 ARE PENDING

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims are abstract and conceptual, as opposed, for instance, to computer-implemented methods and systems.

2. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "partially independent" in claim 1 is a relative term which renders the claim indefinite. The term "partially independent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Independence is a binary term, true or false.

The term "an internal or external nature" in claim 1 is a relative term which renders the claim indefinite.

The term "an internal or external nature" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

From the claim language, there is more than one such "nature" and it is not at all clear what they might be. In the interest of compact prosecution, it is considered that the search engine is either internal or external.

Both of these ambiguities fail to be corrected by the dependent claims 2-6.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz, US 6,029,195, 22 February 2000.

Herz is directed to identification of desirable objects via either the Internet or an intranet [ABSTRACT; FIG 1; COL 31 lines 13-21 and elsewhere].

As to **claim 7**, to the extent that claim 7 is not clearly anticipated by Herz, Herz repeatedly refers to multiple users of the system who search for target information from multiple sources [FIG 1; COL 5 lines 6-20 and elsewhere].

As to **claim 8**, box **1604** of FIG 16 depicts matching a query (a request) with an information source. The resulting retrieval is noted in box **1608**. The target objects are generally characterized by attributes determined by a query, but the sources of desirable objects are varied on dimensions that are not determined by user profiles. See COL 6 line 59 and after, where the sources may include news, electronic mail, published documents, and product descriptions. In particular note COL 7 lines 24-29, where either a movie or a novel might match a user interest. These generally have distinct sources, and this aspect of the system is further discussed at COL 7 line 58 and after. Another aspect of this limitation is discussed with respect to a user query that can generate a response from multiple experts [COL 83 line 29 and after]. Another aspect is related to properties such as availability of servers [COL 78 line 38 and after]. Multiple source domains are also addressed at COL 74 line 7 and after. Herz also addresses the use of attributes such as the number of target objects available at a source [COL 71, line 24 and after]. Another aspect of the source that is addressed is bandwidth [COL 37 line 32 and after]. Herz discusses attributes of virtual channels that are not tied to specific attributes of requests at COL 35 line 56 and after.

As to **claim 9**, see COL 31 lines 13-14; COL 37 lines 29-31 and 50-57.

As to **claim 10**, Internet service providers are frequently accessed with local phone numbers, and access on an intranet clearly is related to the location of a user. As noted in FIG 16, location of a server is a component of the process of determining a network vendor, and clearly location in such a case is related to the location of a user with respect to a vendor.

A specific example in Herz at COL 10 lines 4-20, directs requests to experts on the basis of qualification, but the attribute that they are employees is independent of the request and related to the location of a user, as is "the user is an employee (employer)".

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz, US 6,029,195, 22 February 2000 in light of Lefkowitz, US 2001/0037250, 1 November 2001.

As to **claim 11**, Herz does not explicitly address a tax rate as a retrieval target, but does teach the retrieval of information from vendors. Lefkowitz is directed to retrieval of information about duty free goods [ABSTRACT; 0004-0005], which inherently is determined by a tax rate applied or not applied at a source. The use of the Internet in Herz is multi-state and global, and **it would have been obvious** to one of ordinary skill in the art at the time of the invention to retrieve a tax rate from a vendor because it determines the effective total cost of goods.

As to **claim 1**, Herz repeatedly provides the choice of Internet and intranet. The former generally requires a Web browser; the latter may not. Virtually any database is managed by a DBMS, is indexed, and is searched with an appropriate search engine.

In the case of a local database, a browser is not required. Lefkowitz teaches a merchant server that is connected to consumers and travel agents (local) as well as such generic databases as an Airline Reservation System and A Credit Card server [FIG 1]. Security information differs between internal and external searches, as it is well known that credit card services require secure searches to access their data, whereas consumers and travel agents do not. Prices in Lefkowitz differ with their source [0011]. Manufacturers and other suppliers typically provide their own search engine(s) [FIG 1 **610, 620**]. Two suppliers in different tax domains would clearly provide a good at differing prices, dependent on the supplier, and hence the search engine applied at the source.

It would have been obvious to one of ordinary skill in the art at the time of the invention to retrieve a distinct price dependent on whether or not a source, and hence search engine, was internal to the user's and/or vendor's tax domain or external to it because the tax domain affects the price.

The elements of **claims 2-6** are rejected in the analysis above and these claims are rejected on that basis.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9700.

WPA


WAYNE AMSBURY
PRIMARY PATENT EXAMINER